

## II. REMARKS

### Preliminary Remarks

Upon entry of this Amendment, claims 1 to 6, 8, 9 and 15 to 23 are pending, of which claims 1, 5, 8, 9, and 15 to 20 are independent. Claims 1 to 6, 8, 9 are amended; claims 15 to 23 are new. Support for the claim amendments and the new claims can be found throughout the specification and claims as originally filed (see, for example, paragraphs [0027] to [0029], original claims 1 to 14, and Examples 1 to 11). Therefore, the applicants believe that no new matter is added.

The applicants respectfully request entry of this response pursuant to 37 C.F.R. §1.116, in that if the examiner maintains the claim rejections, this response places the application in better form for appeal. This response is filed within the shortened statutory period for response and is accompanied by a Fee Transmittal and a check for the new independent claims. The applicants respectfully request reconsideration and allowance of the present application.

### Patentability Remarks

#### *Rejections under 35 U.S.C. §103 –*

Claims 1, 3 to 9, 11, and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Saettone *et al.* (U.S. Pat. No. 6,346,273) in view of Müller *et al.* (U.S. Pat. No. 6,407,079). The applicants respectfully traverse in view of the preceding claim amendments and succeeding remarks.

Claims 7, 11 and 13 are canceled. Claims 1, 3 to 6, 8, and 9 are amended to limit the complexing/solubilizing agent to a cyclodextrin agent. In contrast, all the compositions of Saettone *et al.* require non-ionic polymer surfactants. Cyclodextrin is not such a surfactant and is the sole complexing/solubilizing agent used in the claimed invention.

The examiner uses Müller *et al.* for the teaching of clear ophthalmic solutions containing cyclodextrins. Müller *et al.* do not, however, teach, or fairly suggest, replacement of the non-ionic surfactants of Saettone *et al.* with cyclodextrins.

Therefore, at best the combination of Saettone *et al.* and Müller *et al.* would result in a composition containing forskolin, non-ionic surfactants, and cyclodextrins - which is clearly not the claimed invention.

The applicants respectfully submit that claims 1, 3 to 9, 11, and 13 are not unpatentable over Saettone *et al.* in view of Müller *et al.* and respectfully request withdrawal of this rejection.

Claims 2, 12, and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Saettone *et al.* in view of Majeed *et al.* (U.S. Pat. No. 5,804,596). The applicants respectfully traverse in view of the preceding claim amendments and succeeding remarks.

Claims 12 and 14 are canceled. As amended, claim 2 is limited to a cyclodextrin agent as the complexing/solubilizing agent. As noted above, all the compositions of Saettone *et al.* require non-ionic polymer surfactants. Majeed *et al.* do not teach or fairly suggest replacement of the non-ionic surfactants of Saettone *et al.* with cyclodextrins. Therefore, Majeed *et al.* do not overcome the limitations of Saettone *et al.* and claim 2 is not unpatentable over Saettone *et al.* in view of Majeed *et al.*

Claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over Saettone *et al.* in view of Spence *et al.* (U.S. Pat. No. 6,540,895). The applicants have deleted claim 10 rendering this rejection moot. Therefore, the applicants respectfully request the withdrawal of this rejection.

Application Serial No.: 10/605,086  
Inventor(s): Majeed *et al.*  
Attorney Docket No.: 108064-00106


### **III. CONCLUSION**

In view of the amendments and remarks above, the applicants respectfully submit that this application is in condition for allowance and request favorable action thereon.

In the event this response is not timely filed, the applicants hereby petition for an appropriate extension of time. The fee for this extension, along with additional fees required, may be charged to Deposit Account No. 01-2300, referencing Attorney Docket No. 108064-00106.

Respectfully submitted,

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